REMARKS

In view of the following remarks, Applicant respectfully requests reconsideration of the present application, and immediate passage to issue.

Objections and Rejections

The Office Action dated April 12, 2007:

1.   rejects claim 1 under 35 U.S.C. § 102(e) as being anticipated by the Gordon patent;

2.   rejects claims 2, 3, and 5-7 under 35 U.S.C. § 103(a) as being unpatentably obvious based upon the Gordon patent in view of United States Patent no. 5,838,678 entitled "Method and Device for Preprocessing Streams of Encoded Data to Facilitate Decoding Streams Back-to Back" which issued November 17, 1998, on an application filed July 24, 1996, by Joseph W. Davis and Shawn M. Hayes ("the Davis, et al. patent"); and

3.   rejects claim 4 under 35 U.S.C. § 103(a) as being unpatentably obvious based upon the Gordon patent in view of United States Patent no. 6,310,919 entitled "Method and Apparatus for Adaptively Scaling Motion Vector Information in an Information Stream Decoder" which issued October 30, 2001, on an applica-

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tion filed September 25, 1998, by Dinei Afonso Ferreira

Florencio ("the Florencio patent").

The Claimed Invention

As recited in twice amended, pending independent method claim

1,[9] the present invention encompasses:

[a] method for producing **a compressed video bitstream
that includes compressed video data for a plurality of
frames from data that specifies a single still image**
         *   *   *
         assembling the compressed video bitstream by
appropriately combining data for:
              at least a single copy of the stored I frame;
              at least one null frame; and
              various headers required for decodability
         of the compressed video bitstream;
whereby decoding of the compressed video bitstream
produces frames of video which produce images that do not
appear to pulse visually. (Emphasis supplied)

The invention solves a problem that appears in images produced

by a conventional Moving Picture Experts Group ("MPEG") decoder

when decoding a conventionally MPEG encoded video bitstream that

reproduce a still image, particularly a still image containing

text. For conventionally encoded MPEG compressed video data,

detail in decoded MPEG still images tends to be lower at the

beginning of each group of pictures ("GOP") when an intra ("I")

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[9]   Pending independent claim 1 was last amended in a
        response to a June 8, 2001, Office Action that was
        received by the USPTO on October 9, 2001, i.e. more than
        sixty-eight (68) months ago (more than five and one-half
        (5-½) years ago).

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frame is decoded, increases during decoding of successive predicted ("P") frames and bidirectional ("B") frames in the GOP, only to decrease again upon decoding the next I frame. Thus, a decoding of the MPEG compressed video bitstream of a still image frequently produces a video image that appears to pulse visually, usually at a frequency identical to the frequency at which GOPs occur in the compressed video bitstream, e.g. twice per second. This visual pulsing of the still image produced by decompressing a MPEG compressed video bitstream in many instances makes them commercially unacceptable.

The Primary Reference
The Gordon Patent

The Gordon patent's invention provides a rapid, computationally efficient method for generating well-behaved movie information screen ("MIS") information streams. "The above-described invention provides an information stream that will produce, upon a presentation device, a **substantially motionless image**"[10] . . . ."

In its "Background of the Disclosure" the Gordon patent states that the then:

> existing methods for generating MIS information streams disadvantageously require extensive encoding of video information to produce well-behaved bitstreams, i.e., bitstreams that do not cause decoder buffer underflow or

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[10]   See the Gordon patent in col. 7 at lines 50-52.

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overflow. For example, an MIS information stream generated by repeatedly encoding an image will produce a well-behaved MIS bitstream at the cost of significant computational resources and time (e.g., two to 30 minutes to encode a two minute MIS display or presentation)." (Col. 1, line 61 - col. 2, line 3)

The Gordon patent's "Summary of the Invention" in col. 2

beginning at line 9 expressly states that:

> [t]he invention comprises a method and apparatus for processing an image to produce an encoded video information stream comprising **a sequence of replicated group of picture (GOP) information structures, each GOP including an intra-coded frame (I-frame) and a plurality of forward predictive coded frames (P-frames)**, wherein the I-frame of the initial GOP is formed by intra-coding the still image, and each P-frame comprises, e.g., a substantially zero motion vector P-frame.
>
>   *   *   *
>
> Specifically, a method according to the invention for processing an image to produce a compressed information stream comprises the steps of: intra-coding the image to produce an intra-coded information frame (I-frame); **associating the intra-coded information frame with a plurality of forward predicted information frames (P-frames) to form a group of pictures (GOP)**; and replicating the GOP to produce the compressed information stream.
>
> An apparatus according to the invention for processing an image to produce an MPEG-like information stream comprises: **a frame encoder**, for producing an intra-coded (I-frame) in response to said image, and **for producing N number of forward predicted information frames (P-frames) in response to said I-frame**, where N is an integer; a memory, for storing said I-frame and said N number of P-frames; and a controller, for causing said memory to repetitively output said I-frame and said N number of P-frames as a video elementary stream. (Emphasis supplied.)

Regarding P-frames, as clearly depicted in the flow diagram of FIG. 3[11] **the Gordon patent presents two (2) ways for encoding an information stream produces a substantially motionless image**.

1. A MIS generator apparatus 100 according to the invention depicted in the block diagram of FIG. 1[12] that preferably uses **pre-defined data structure NULL P-frames** that are simply inserted into the appropriate memory location following the stored I-frame.[13]

2. An embodiment in which a **frame encoder 110**, included in the apparatus 100 depicted in FIG. 1, **actually performs a predictive encoding operation for each of N P-frames that form the initial GOP structure** whereby the frame encoder 110 provides both the GOP's:

    a. I-frame; and

    b. N P-frames.[14]

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[11] A first at the middle of the flow diagram of FIG. 3 in block 335, and a second along the left hand side of the flow diagram through blocks 327, 328 and 329.

[12] See the Gordon patent in col. 3 at lines 13-14.

[13] See the Gordon patent in col. 4, line 55-58 and col. 6, lines 55-56.

[14] See the Gordon patent in col. 4, line 66 - col. 5, line 6.

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Regarding the first embodiment for the MIS generator apparatus

100 illustrated in FIG. 1 the Gordon patent in col. 4 at lines

53-63 expressly states as follows.

> **In the above-described apparatus 100, the GOP replicator 120 utilizes the insertion of N NULL P-frames, where N is an integer, after an I-frame to form a GOP. In this embodiment of the invention each of the NULL P-frames comprises a pre-defined data structure** that is simply inserted into the appropriate memory location following the stored I-frame. **In the case of an MPEG2 information stream, a NULL frame utilized by the inventor comprises a 38 byte data structure** that informs the decoder to utilize all the macroblocks from the previous anchor frame and to do so without displacing the macroblocks (i.e., zero motion vectors). (Emphasis supplied.)

Regarding the second alternative embodiment for the MIS

generator apparatus 100 illustrated in FIG. 1 as described in col.

4, line 66 - col. 5, line 6, the Gordon patent further expressly

discloses:

> **[a] NULL forward predictive coded frame comprises a "zero motion vector frame** (i.e., a P-frame having relatively inconsequential motion vectors) **based on an anchor frame, e.g., the still image representative I-frame**. Thus, each NULL [forward predictive] P-frame, when decoded, will produce **a picture that is virtually identical** to the anchor frame from which it is based. (Col. 3, lines 41-47) (Emphasis supplied.)

> **Predictive encoding of the NULL P-frames is not the preferred embodiment of the invention;** however, such [forward] predictive encoding may be convenient in some cases where the encoder circuitry or functionality of a system is not readily adaptable to the preferred NULL P-frame insertion process. (Col. 6, lines 55-60) (Emphasis supplied.)

It must be noted that **the P-frames may be NULL P-frames (as previously described) or P-frames that have been [forward] predicted**, in the standard manner, using the initial I-frame. (Col. 7, lines 54-57) (Emphasis supplied.)

A description of the Gordon patent's invention as illustrated in a flow diagram of FIG. 3 appears in col. 6 at lines 27-49.

The routine 300 then proceeds to step 326, where a query is made as to whether the N P-frames utilized in the formation of the GOP structure are to be predicted (using, e.g., the frame encoder) or inserted (i.e., NULL P-frame insertion). **If the query at step 326 is answered in a manner indicating that the P-frames are to be inserted, then the routine 300 proceeds to step 335, where N NULL P-frames are added to the GOP buffer after the I-frame stored in the buffer at step 325.** The routine 300 then proceeds to step 340. **If the query at step 326 is answered in a manner indicating that the P-frames are to be predicted**, then the routine 300 proceeds to step 327, where the encoded I-frame is stored in, e.g., an anchor frame buffer 111 associated with the frame encoder 110. **The routine 300 then proceeds to step 328, where the frame encoder performs N forward predictive operations utilizing the stored I-frame (or the original input frame I) to produce N NULL P-frames.** The routine 300 then proceeds to **step 329, where the N NULL P-frames are stored in the GOP buffer after the I-frame stored in the buffer at step 325.** Thus, a single group of pictures (GOP) is produced comprising an I-frame followed by N P-frames. In the exemplary embodiment N is equal to 14, however, N can be any number. The routine 300 then proceeds to step 340. (Emphasis supplied.)

Legal Principles Applicable to 37 C.F.R. § 1.131 Declarations

A rejection based on 35 U.S.C. § 102(e) can be overcome by:
(A) Persuasively arguing that the claims are patentably distinguishable from the prior art;
* * *

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(D) Filing an affidavit or declaration under 37 C.F.R. § 1.131 showing prior invention, **if the reference is not a U.S. patent . . . claiming the same patentable invention as defined in 37 C.F.R. § 41.203(a)**. (MPEP Eighth Edition Rev. 5, August 2006, pp. 700-26 - 700-27, § 706.02(b)) (Emphasis supplied.)

Affidavits or declarations under 37 CFR 1.131 may be used, for example:

* * *

(B) **To antedate a reference that qualifies as prior art under 35 U.S.C. 102(e), where the reference** has a prior art date under 35 U.S.C. 102(e) prior to applicant's effective filing date, and **shows but does not claim the same patentable invention**. (MPEP Eighth Edition Rev. 5, August 2006, pp. 700-270 - 700-274, § 715) (Emphasis supplied.)

Legal Principles Applicable
Rejections under 35 U.S.C. § 102

The **disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter**; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. Manual of Patent Examining Procedure ("MPEP") Eighth Edition Rev. 5, August 2006, p. 2100-55, § 2121.01 supra citing Elan Pharm., Inc. v. Mayo Foundation for Medical and Education Research, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003). (Emphasis supplied.)

Legal Principle
of Estoppel

Estoppel is a bar or impediment (obstruction) which precludes a person from asserting a fact or a right or prevents one from denying a fact. Such a hindrance is due to a person's actions, conduct, statements, admissions, failure to act . . . . Estoppel includes being barred by . . . , failure to take legal action until the other party is prejudiced by the delay (estoppel by laches) . . . . Law.COM

> For example, regarding interference estoppel MPEP Eighth Edition Rev. 5, August 2006, p. 2300-22, § 2308.03 entitled "Estoppel Within the Office" states that there are two different types thereof.
>> First, a losing party is barred on the merits from seeking a claim that would have been anticipated or rendered obvious by the subject matter of the lost count.
>> *   *   *
>> Second, **a losing party is procedurally barred from seeking from the examiner relief that could have been--but was not--sought in the interference**. (Emphasis supplied.)

Argument

As stated above in the Introductory Remarks, the April 12, 2007, Office Action rejects pending independent claim 1 under 35 U.S.C. § 102(e) as being anticipated by the Gordon patent. As also stated there, Applicant maintains that the claims pending in this patent application traverse rejection based upon the Gordon patent for each and every one of the following three (3) reasons.

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1. The claims of the Gordon patent differ patentably from the subject matter encompassed by pending independent claim 1, and the Conover Declaration establishes a reduction to practice for this application's invention which precedes the filing date of the Gordon patent.

2. Even if the Gordon patent and the present application might possibly **claim** the same invention, and even if the Applicant had not reduced this application's invention to practice before the filing date of the Gordon patent:

   a. the Conover Declaration establishes that the Gordon patent lacks an enabling disclosure of the subject matter encompassed by independent claim 1 pending in this patent application, i.e. pre-defined data structure NULL frames; and

   b. lacking an enabling disclosure, controlling precedent identified in Manual of Patent Examining Procedure ("MPEP") Eighth Edition Rev. 5, August 2006, p. 2100-55, § 2121.01 prohibits applying the Gordon patent in rejecting independent claim 1 under 35 U.S.C. § 102(e).

3. The prior acceptance of the Conover Declaration as traversing the rejection of independent claim 1 under 35 U.S.C. § 102(e) combined with the failure to mention the Gordon patent for more than three and one-half (3-½) years in two (2) successive

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Office Actions[15] and throughout Applicant's successful appeal of claim rejections appearing in those two (2) Office Actions:

a.   constitutes res judicata on the issue of rejecting pending independent claim 1 under 35 U.S.C. § 102(e) based upon the Gordon patent; and

b.   at least, now procedurally estops rejecting independent claim 1 under 35 U.S.C. § 102(e) based upon the Gordon patent.

**The Gordon Patent's
Claimed Invention**

The Gordon patent includes three (3) independent claims 1, 10 and 13 presented in a side-by-side comparison in Exhibit A to this Response. These independent claims respectively encompass:

1.   "**forwarded predicted information frames (P-frames)**" associated with an intra-coded information frame (I-frame);[16]

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15   The October 11, 2002, and March 18, 2003, Office Actions.

16   See the Gordon patent independent claim 1, col. 8, lines 53-57.

2.   "substantially zero motion vector **forward predicted (P-frame)** **information frames**" associated with an intra-coded information frame (I-frame);[17] and

3.   "a frame encoder, for producing an intra-coded (I-frame) in response to said image, and **for producing forward predicted information frames (P-frames) in response to said I-frame**."[18]

The text of independent claim 13 expressly encompasses only the second, less preferred embodiment of the invention described in col. 4, line 66 - col. 5, line 6 which describes using a plurality of forward predictive coded frames (P-frames) created by the apparatus 100 actually performing a predictive encoding operation. Since the Gordon patent's independent claims, i.e. claims 1, 10 and 13, all use the phrase "**forwarded predicted information frames (P-frames)**" independent claims 1 and 10 must also encompasses only the second, less preferred embodiment of the invention described in col. 4, line 66 - col. 5, line 6 which describes using a plurality of forward predictive coded frames (P-frames) created by the apparatus 100 actually performing a predictive encoding operation.

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[17]   See the Gordon patent independent claim 10, col. 9, lines 32-38.

[18]   See the Gordon patent independent claim 13, col. 10, lines 6-9.

Docket no. 2134   June 12, 2007

Confirming the preceding constructions of the Gordon patent's

independent claims 1, 10 and 13, the reference's "Background of the

Disclosure" in col. 1 at lines 28-38 characterizes compression and

delivery of video as follows.

> In particular, the above-referenced standards,[19] and
> other "MPEG-like" standards and techniques, compress,
> illustratively, video information using intra-frame
> coding techniques (such as run-length coding, Huffman
> coding and the like) and **inter-frame coding techniques
> (such as forward and backward predictive coding, motion
> compensation and the like)**. Specifically, in the case of
> video processing systems, **MPEG and MPEG-like video
> processing systems are characterized by prediction-based
> compression encoding of video frames** with or without
> intra- and/or inter-frame motion compensation encoding.
> (Emphasis supplied.)

The Gordon patent's "Summary of the Invention" appearing in col. 2,

lines 10-42 also confirms that independent claims 1, 10 and 13

encompass only the second, less preferred embodiment of the

invention described in col. 4, line 66 - col. 5, line 6 which

describes using a plurality of forward predictive coded frames

(P-frames) created by the apparatus 100 actually performing a

predictive encoding operation.[20]

Based upon:

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[19]   MPEG-1 and MPEG-2 and ATSC A/53 identified in col. 1,
        lines 12-23.

[20]   The word "null" appears nowhere in the Gordon patent's
        "Summary of the Invention."

1.   the texts of the Gordon patent's independent claims 1, 10 and
     13 excerpted above;

2.   the description of compression and delivery of video described
     in the Gordon patent's "Background of the Disclosure" excerpt-
     ed above;

3.   the Gordon patent's "Summary of the Invention;" and

4.   upon the previously excerpted texts describing in detail the
     Gordon patent's invention;

**Applicant respectfully submits the Gordon patent's independent
claims, i.e. claims 1, 10 and 13, are all limited to the second,
less preferred embodiment of the invention described in col. 4,
line 66 - col. 5, line 6 which describes using a plurality of
forward predictive coded frames (P-frames) created by the apparatus
100 actually performing a predictive encoding operation.**[21]

**The Present Application
and The Gordon Patent
Claim Different Inventions**

Based upon the immediately preceding analysis of the Gordon
patent's independent claims 1, 10 and 13, and upon the preceding
description of presently pending independent claim 1, Applicant

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[21]   Applicant does not argue or even suggest that the Gordon
       patent lacks an enabling disclosure of forward predictive
       coded frames (P-frames) generated by the apparatus 100
       actually performing a predictive encoding operation.

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respectfully submits that **the present application and the Gordon patent claim different inventions**. The present application discloses only **pre-defined data structure NULL P-frames** as contrasted with the Gordon patent's **claimed** second, less preferred embodiment of the invention described in col. 4, line 66 - col. 5, line 6 of the Gordon patent which describes using a plurality of **forward predictive coded frames (P-frames) created by the apparatus 100 actually performing a predictive encoding operation**. Accordingly, in accordance with MPEP § 715 excerpted above **Applicant respectfully submits that:**

1. **the July 12, 2002 Conover Declaration traverses the rejection of independent claim 1 under 35 U.S.C. § 102(e) because the Gordon patent "shows but does not claim the same patentable invention;"**[22] and

2. therefore the abandonment of the rejection of pending independent claim 1 under 15 U.S.C. § 103(e) based upon the Gordon patent appearing in the October 11, 2002, Office Action is sound and proper.

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[22] **Affidavits or declarations under 37 CFR 1.131 may be used to antedate a reference** that qualifies as prior art under 35 U.S.C. 102(e), **where the reference** has a prior art date under 35 U.S.C. 102(e) prior to applicant's effective filing date, and **shows but does not claim the same patentable invention**. (MPEP § 715 supra) (Emphasis supplied.)

**The Gordon Patent Lacks
an Enabling Disclosure of
Pre-Defined Null P-Frames**

Assuming merely for the sake of argument that, contrary to the preceding analysis, the Gordon patent did in fact include a claim which validly encompasses pre-defined data structure NULL P-frames, **Applicant respectfully submits that controlling legal authority bars rejecting pending independent claim 1 under 35 U.S.C. § 102(e) based upon the Gordon patent because the reference lacks an enabling disclosure of pre-defined data structure NULL P-frames.**[23]

Applicant first observes that the Gordon patent lacks a description of pre-defined data structure null frames in a detail which corresponds to the description thereof appearing on pages 20-30 of the present application. Applicant further observes that the most detailed description of the Gordon patent's pre-defined data structure NULL P-frames appears in col. 4, lines 43-65. In that text the Gordon patent expressly states that "[i]n the case of an **MPEG-2** information stream, **a NULL frame utilized by the inventor comprises a 38 byte data structure** . . . ."

Regarding the preceding excerpt from the Gordon patent, the July 12, 2002, Conover Declaration in paragraph 21.c. on pages 5-6 states:

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[23]   See citation in footnote no. 4 supra.

c.   The Gordon patent states in col. 4 at lines 58-63
     that:

> [i]n the case of an MPEG2 information stream, a
> NULL frame utilized by the inventor comprises a 38
> byte data structure that informs the decoder to
> utilize all the macroblocks from the previous
> anchor frame and to do so without displacing the
> macroblocks (i.e., zero motion vectors).

> MPEG-2 cannot escape past a slice, and a slice can not
> extend past a horizontal scan line. Therefore, the
> preceding statement is incorrect because the minimum
> amount of data required to encode a single 720×480 frame
> in accordance with the MPEG-2 specification is 318 bytes,
> not 38 bytes as disclosed in the text quoted above from
> the Gordon patent.

Thus, the July 12, 2002, Conover Declaration proves that **the only
detail provided in the Gordon patent regarding pre-defined data
structure NULL P-frames**, i.e. that a 38 byte data structure
provides a NULL frame for an MPEG-2 information stream, **is false**.

**Since the Gordon patent fails to disclose or to even suggest
a pre-defined data structure that provides a NULL frame for an MPEG
information stream and since the Gordon patent's limited disclosure
on that subject is false,**[24] **Applicant respectfully submits that the
reference lacks an enabling disclosure of pre-defined data
structure NULL P-frames.** Consequently, even if one were to assume
merely for the sake of argument that the Gordon patent included a

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[24]   Arguably, the Gordon patent's false disclosure regarding
       a pre-defined data structure for NULL P-frames would lead
       one of ordinary skill away from rather than toward the
       invention encompassed by pending independent claim 1.

claim which validly encompasses pre-defined data structure NULL

P-frames, **Applicant respectfully submits that**:

1. **controlling legal authority bars rejecting pending independent claim 1 under 35 U.S.C. § 102(e) based upon the Gordon patent because the reference lacks an enabling disclosure of pre-defined data structure NULL P-frames**;[25] and

2. therefore the abandonment of the rejection of pending independent claim 1 under 15 U.S.C. § 103(e) based upon the Gordon patent appearing in the October 11, 2002, Office Action is sound and proper.

The April 12th Office Actions
Response to Applicant's Arguments

The April 12th Office Action analysis of and response to Applicant's arguments that **the Gordon patent and the present application claim different inventions** appears on the Office Action's pages 5-6 in one paragraph excerpted below, and at particular locations in the subsequent paragraph on pages 6 also excerpted below.

> The applicant argued at pages 7-14 of the amendment filed February 2, 2006 concerning the description of the two embodiments of the Gordon patent, and specifically that a rejection based on 35 U.S.C. 102(e) can be overcome by (A) persuasively arguing that the claims are patentably distinguishable from the prior art; and (D)

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[25]   See citation in footnote no. 4 supra.

filing an affidavit or declaration under 37 C.F.R. 1.131 showing prior invention as defined in 37 C.F.R. 41.203 (a) and MPEP 706.02(b), and 37 CFR 1.131 affidavits or declarations may be used to antedate a reference that qualifies as prior art under 35 USC 102(e), where the reference has a prior art data under 35 US C 102(e) prior to applicant's effective filing date, and shows but does not claim the same patentable invention. The applicant's attention is directed to MPEP 706.02(b), section (D), which states that "When the claims of the reference U.S. patent or U.S. patent application publication are directed to the same invention or are obvious invariants, an affidavit or declaration under 37 CFR 1.31 is not an acceptable method of overcoming the rejection". Contrary to applicant's contention, the present 35 U.S.C. 102 (e) therefore can not be overcome by an affidavit or declaration under 37 CFR 1.131 for reasons as set forth in MPEP 706.02(b) and **since the Gordon patent is directed to the same patentable/claimed invention**.

The applicant argued at pages 14-23 of the amendment filed February 2, 2006 concerning in general the traversal of the rejection under 35 USC 102(e) based upon the Gordon patent because the Gordon patent claims differ patentably from the subject matter encompassed by pending claim 1 . . . , and specifically that "the Gordon patent's independent claims, i.e. claims 1, 10 and 13, are all limited to the second, less preferred embodiment of the invention described in col. 4, line 66 - col. 5, line 6 ... The present application discloses only predefined data structure NULL P-frames as contrasted with the Gordon patent's claimed second , less preferred embodiment of the invention ...

<p align="center">*   *   *</p>

The Examiner respectfully disagrees. Contrary to the applicant's contention that the predefined data structure NULL frames as disclosed in the present application is contrasted with Gordon patent's claimed second embodiment which describes using a plurality of forward predictive coded frames (P-frames), **the Examiner sees no difference between the NULL frames of the present application and the NULL frames of the Gordon patent** (see column 4, lines 53-65). Also, **contrary to the applicant's contention, the Gordon patent clearly claims the same patentable invention.** (Emphasis supplied.)

<p align="center">-32-</p>

Regarding the preceding excerpt from the April 12th Office Action, Applicant first notes that, except for the final two (2) lines of the first paragraph that appear on page 6 and five (5) lines in the second paragraph that also appear on page 6, the preceding excerpt consists of nothing but citations to:

1.   Applicant's Response filed February 2, 2006; and

2.   MPEP(b)(D).

The only fact appearing in the preceding excerpt is a citation without any analysis to column 4, lines 53-65 of the Gordon patent. The cited text of Gordon appears immediately below.

> In the above-described apparatus 100, the GOP replicator 120 utilizes the insertion of N NULL P-frames, where N is an integer, after an I-frame to form a GOP. In this embodiment of the invention each of the NULL P-frames comprises a pre-defined data structure that is simply inserted into the appropriate memory location following the stored I-frame. In the case of an MPEG2 information stream, a NULL frame utilized by the inventor comprises a 38 byte data structure that informs the decoder to utilize all the macroblocks from the previous anchor frame and to do so without displacing the macroblocks (i.e., zero motion vectors). In essence, the NULL P-frames are interpreted by a decoder as "repeat last anchor frame" commands. (Emphasis supplied.)

Applicant first notes that the preceding excerpt is from the Gordon patent's specification, and not from the reference's claims. Therefore, assuming merely for the sake of argument that **there exists no difference between the NULL frames of the present application and the NULL frames disclosed in the Gordon patent**, because the Gordon patent discloses in column 6 at lines 27-31 and

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depicts in FIG. 3 two (2) distinctly different ways of producing N P-frames utilized in the formation of the reference's GOP structure as being either:

1.   predicted (using, e.g., the frame encoder); or

2.   inserted (i.e., NULL P-frame insertion);

the portion of the Gordon patent's specification cited in the April 12th Office Action does not even support a claim that the Gordon patent and the present application claim the same invention. At best, all the Gordon patent's text in column 4 at lines 53-65 may prove is that both the Gordon patent and the present application disclose the same invention. Only a citation to and analysis of the Gordon patent's claims in view of the claims pending in the present application could possibly justify a conclusion that the Gordon patent and present application claim the same invention.

Consequently, because the April 12th Office Action lacks analysis of the Gordon patent's claims in view of the claims pending in the present application, the preceding excerpts from the Office Action merely state the conclusion that "**the Gordon patent is directed to the same patentable/claimed invention**." Applicant notes further that page 7 of the BPAI's June 7, 2005, decision reversing the rejections of all claims pending in this patent application criticizes claim rejections which only state a conclusion without any concrete evidence. Consequently, because

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the April 12th Office Action merely states a conclusion without

pointing to any concrete evidence supporting that conclusion,

Applicant respectfully requests that:

1. the conclusion that "**the Gordon patent is directed to the same**

   patentable/claimed invention" be withdrawn for lack of eviden-

   tiary support;[26] and

2. the prior conclusion that the Conover Declaration traverses

   all rejections based upon the Gordon patent be reinstated.

The April 12th Office Action analysis of and response to

Applicant's arguments that **the Gordon patent lacks an enabling**

disclosure appears on the Office Action's pages 6-7 in particular

portions of a single paragraph excerpted below.

> The applicant argued at pages 14-23 of the amendment
> filed February 2, 2006 concerning in general the travers-
> al of the rejection under 35 USC 102(e) based upon the
> Gordon patent because . . . the Gordon patent lacks
> an enabling disclosure of pre-defined data structure NULL
> frames, ...
>   *   *   *
> The Examiner respectfully disagrees.
>   *   *   *
> And regarding the lack of an enabling disclosure by
> Gordon as argued by the applicant, the Examiner wants to
> point out that MPEP 2121 states that "When the reference
> is relied on expressly anticipates or makes obvious all
> of the elements of the claimed invention, **the reference
> is presumed to be operable**", and "The level of disclosure
> required within a reference to make it an "enabling

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26   Differing markedly from the analysis provided above by
the Applicant, nowhere does April 12th Office Action
provide any factual analysis distinguishing what the
Gordon patent discloses and what the reference claims.

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disclosure" is the same no matter what type of prior art is at issue. It does not matter whether the prior art reference is a U.S. patent, foreign patent, a printed publication or other". Therefore, **it is submitted that the Gordon patent contains an enabled disclosure and anticipates the claimed invention**. (Emphasis supplied.)

Applicant respectfully submits that facts appearing on pages 2-7 of the Conover Declaration establish a prima facie case that the Gordon patent lacks an enabling disclosure of the subject matter disclosed and claimed in the present invention. **The preceding excerpt from the April 12th Office Action seeks to rebut Applicant's prima face case that the Gordon patent lacks an enabling disclosure with a presumption. If the statement appearing in the April 12th Office Action were correct, then it would be impossible to ever invalidate an issued United States patent by proving that it lacks an enabling disclosure.**

Clearly, since patents are regularly invalidated because they lack an enabling disclosure, in dismissing Applicant's argument that the Gordon patent lacks an enabling disclosure the April 12th Office Action's improperly relies upon only a presumption. Consequently, because **the April 12th Office Action relies upon only a presumption that the Gordon patent provides an enabling disclosure of the invention disclosed and claimed in the present patent application and provides no concrete evidence which contradicts Applicant's evidence establishing a prima facie case that the**

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Gordon patent lacks an enabling disclosure, Applicant respectfully requests that:

1. the conclusion that "**the Gordon patent contains an enabled disclosure and anticipates the claimed invention**" be withdrawn for lack of evidentiary support; and

2. claims 1-7 now pending in this patent application be declared allowable over the non-enabling disclosure of the Gordon patent.

Conclusion

Applicant first wants to specifically point out that each of the three (3) arguments presented in this Response to the April 12th Office Action are independent, i.e. each argument stands alone and independent from the other two arguments. Stated succinctly, for the reasons set forth in detail above, Applicant's arguments establish that the claims now pending in this application are allowable:

1. because pending claims 1-7 encompass a different invention than that encompassed by claims 1-21 of the Gordon patent;

2. because the Gordon patent lacks an enabling disclosure of the subject matter encompassed by pending claims 1-7; and
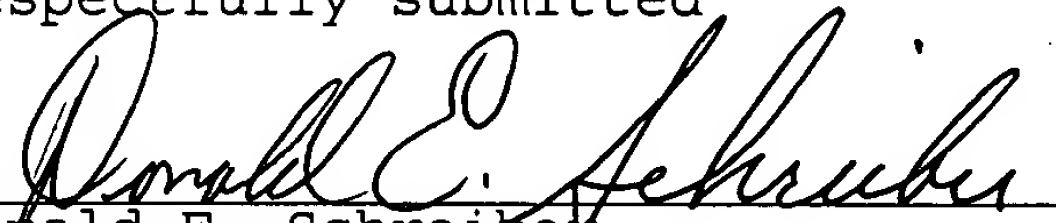
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3.   because under principles of res judicata and estoppel the former decision[27] that the Conover Declaration traverses a rejection under on 35 U.S.C. 102(e) based on the Gordon patent now bars reinstating again that basis for rejecting claims 1-7.

Therefore, Applicant respectfully submits that:

1.   independent claim 1 together with claims 2-7 depending therefrom are all patentable over the Gordon patent;

2.   the rejection of independent claim 1 appearing in the April 12, 2007, Office Action must be withdrawn together with the rejection of claims 2-7 depending therefrom; and

3.   the present application must pass promptly to issue.

Respectfully submitted

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Dated: _____12 June_____, 200 7

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[27]   A decision made and communicated to the Applicant more than four and one-half (4-½) years ago in the October 11, 2002 Office Action.

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